

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 19-22 are canceled and new claims 29-34 are added. Claims 12-14 and 23-28 were previously withdrawn. Claims 1-11, 15-18, and 29-34 are now pending in the application.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

#### **a. claim amendments and cancellations**

With particular reference to the claim amendments, Applicants note that new claims 29-34 have been added herein. Applicants note that while claims 19-22 have been canceled herein, such cancellations have been made in the interest of expediting the allowance of this case. Notwithstanding, Applicants, may, on further consideration, determine that claims of broader scope than those now presented are supported. Accordingly, Applicants hereby reserve the right to file one or more continuing applications with claims broader in scope than the claims now presented.

Consistent with the points set forth above, Applicants submit that neither the claim cancellations and new claims set forth herein, nor any other claim amendments, claim cancellations or statements advanced by the Applicants in this or any related case, constitute or should be construed as, an implicit or explicit surrender or disclaimer of claim scope with respect to the cited, or any other, references.

#### **b. remarks**

Applicants respectfully note that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the patentable distinctions between any cited references and the invention, example embodiments of which are set forth in the claims of this application. Rather, and in consideration of the fact that various factors make it impractical to enumerate all the patentable distinctions between the invention and the cited art, as well as the fact that the Applicants have broad discretion in terms of the identification and consideration of the base(s) upon which the claims distinguish over the cited references, the distinctions identified

and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration by the Applicants, in this case or any other, of: additional or alternative distinctions between the invention and the cited references; and/or, the merits of additional or alternative arguments.

Applicants note as well that the remarks, or a lack of remarks, set forth herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicants: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicants reserve the right to challenge the purported teachings and purported prior art status of the cited references at any appropriate time.

## **II. Priority Claim**

The Examiner has asserted that “the disclosure of the prior-filed application, Application No. 60/474,044, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for claims 15-18 of this application. Therefore, claims 15-18 have not been accorded the benefit of the earlier filing date.” Applicants respectfully disagree, and reserve the right to challenge this assertion at any appropriate time.

## **III. Claim Rejections under 35 U.S.C. § 102**

Applicants respectfully note that a claim is anticipated under 35 U.S.C. § 102(b) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure (“MPEP”) § 2131.*

The Examiner has rejected claims 1, 3-6, and 11 under 35 U.S.C. § 102(b) as being anticipated by Your Employment Risk Solution, Inc. (retrieved from the Wayback Machine as of May 24, 2002) (“YERS”). The Examiner has also rejected claims 15-18 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2007/0203713 A1 to Habichler et al. (“Habichler”). The Examiner has also rejected claims 19-22 under 35 U.S.C. § 102(e) as

being anticipated by U.S. Patent No. 7,330,817 B1 to Exall et al. (“*Exall*”). Applicants respectfully disagree, and submit that at least for the following reasons the rejections should be withdrawn.

**a. rejections of claims 1, 3-6, and 11**

In his rejection of independent claim 1, and presumably of independent claim 11, the Examiner has asserted that “YERS discloses... making the plurality of human resources compliance forms available to a client and in an order that is dynamically controlled at least in part by the legal criteria and status data corresponding to the client; (page 1, ¶ 3)...” *Office Action, page 5-6 (emphasis added)*. Despite this assertion of the Examiner, however, the Examiner has failed to demonstrate that the portion of YERS cited by the Examiner teaches “making the plurality of human resources compliance forms available to a client and in an order that is dynamically controlled at least in part by the legal criteria...” as required by claims 1 and 11. On the contrary, the term “order” is not found in the paragraph of YERS cited by the Examiner, nor does the concept of “an order that is dynamically controlled at least in part by the legal criteria...” appear to be found in said cited paragraph. Instead, the citation simply explains that “The program focuses on key legal issues and provides detailed explanations of all applicable laws and regulations...” YERS at page 1, ¶ 3. This vague statement falls well short of suggesting, much less disclosing, the aforementioned elements of the claims.

In light of the foregoing, Applicants respectfully submit that the Examiner has not established that YERS anticipates claims 1 and 11, at least because the Examiner has not established that each and every element as set forth in amended claims 1 and 11 is found in YERS, because the Examiner has not established that the identical invention is shown in YERS in as complete detail as is contained in claims 1 and 11, and because the Examiner has not shown that YERS discloses the elements arranged as required by claims 1 and 11. Applicants thus respectfully submit that the rejections of claims 1 and 11, as well as the rejections of corresponding dependent claims 3-6, should be withdrawn.

**b. rejections of claims 15-18**

In his rejection of independent claim 15, the Examiner has asserted that:

[Habichler] discloses...

....

a first interface portion configured to provide a client access to a plurality of forms for use in a human resources process, wherein client access to the forms

is controlled at least in part by legal criteria governing the human resources process, and wherein at least one of the forms is dynamically updated by the server to reflect changes in the legal criteria;

a second interface portion configured to reflect changes in the legal criteria; and

a third interface portion configured to reflect status data of employees working for the client, the at least one updated form being customized for at least one of the employees based on the status of the at least one employee.

*Office Action, page 8 (emphasis added).* Despite these assertions of the Examiner, however, the Examiner has failed to demonstrate that the portion of *Habichler* cited by the Examiner teaches that “client access to the forms is controlled at least in part by legal criteria governing the human resources process...” or that “at least one of the forms is dynamically updated by the server to reflect changes in the legal criteria,” or that an interface portion of *Habichler* is “configured to reflect changes in the legal criteria,” as required by independent claim 15. On the contrary, the terms “legal criteria,” “forms” and “human resources,” for example, are nowhere to be found in the portions of *Habichler* cited by the Examiner.

Additionally, Applicants respectfully note that the Examiner has not clearly identified what the Examiner believes to be the correspondence between the element(s) of the cited portion of *Habichler* and the elements of the claim. As but a few examples, the Examiner has not identified which elements in the cited portion of *Habichler* allegedly correspond to the claim elements “first interface portion,” “second interface portion,” and “third interface portion.”

In this regard, Applicants note that such a vague reference to *Habichler*, without more, is not adequate to discharge the duties imposed on the Examiner by 37 CFR 1.104(c)(2), which provides in part that:

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

Emphasis added.

In light of the foregoing, Applicants respectfully submit that the Examiner has not established that *Habichler* anticipates claim 15, at least because the Examiner has not established

that each and every element as set forth in amended claim 15 is found in *Habichler*, because the Examiner has not established that the identical invention is shown in *Habichler* in as complete detail as is contained in claim 15, and because the Examiner has not shown that *Habichler* discloses the elements arranged as required by claim 15. Applicants thus respectfully submit that the rejection of claim 15, as well as the rejections of corresponding dependent claims 16-18, should be withdrawn.

**c. rejections of claims 19-22**

Applicants respectfully disagree with the Examiner's rejections of claims 19-22. Nevertheless, in light of the cancellation of claims 19-22 herein, Applicants respectfully submit that the rejections of claims 19-22 have been rendered moot and should be withdrawn.

**IV. Claim Rejections under 35 U.S.C. § 103**

Applicants respectfully note at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to clearly articulate the reason(s) why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. See *MPEP* § 2141.III. As stated by the U.S. Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_, 82 USPQ2d 1385 (2007), the analysis supporting a rejection made under 35 U.S.C. § 103 should be made explicit. Moreover, the Court also stated in *KSR* that "...[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1396.

The Examiner has rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over *YERS*. The Examiner has also rejected claims 8-10 under 35 U.S.C. § 103(a) as being anticipated by *YERS* in view of *Exall*. Applicants respectfully disagree, and submit that at least for the following reasons the rejections should be withdrawn.

In view of their dependence from claim 1, claims 2 and 8-10 require all the elements of claim 1. As discussed above in connection with the rejection of claim 1 however, the Examiner has failed to demonstrate that the cited references teach or suggest all the elements of claim 1.

Applicants thus submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 2 and 8-10 at least because the Examiner has failed to demonstrate that the references, when combined in the purportedly obvious fashion, teach or

suggest all the elements of those claims. Applicants accordingly submit that the rejection of claim 2 and 8-10 should be withdrawn.

**V. New Claims 29-34**

Applicants have herein added new claims 29-34. Support for one or more these new claims can be found at least in paragraphs [0052]-[0054], as well as Figure 2, of the specification. Because these claims each depend from independent claim 1, Applicants submit that these claims are allowable at least for the reasons discussed in Section **III** above.

**CONCLUSION**

In view of the foregoing, Applicants believe that claims 1-11, 15-18, and 29-34 are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 8th day of September 2008.

Respectfully submitted,

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